

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS:	Pahl, et al.)	ATTORNEY DOCKET:	04266864
)		
SERIAL NO.:	10/828,650)	GROUP ART UNIT:	1624
)		
PATENT NO.:	7,381,729)		
)		
FILED:	April 21, 2004)	EXAMINER:	Susanna Moore
)		
TITLE:	4-(4-TRANS-HYDROXYCYCLOHEXYL) AMINO-2-PHENYL-7H-PYRROLO [2,3D] PYRIMIDINE HYDROGEN MESYLATE, ITS POLYMORPHIC FORMS, AND METHODS FOR MAKING SAME			
DATE:	June 25, 2008			

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF THE DECEMBER 7, 2007
APPLICATION FOR PATENT TERM ADJUSTMENT**

This Request for Reconsideration of the December 7, 2007 Application for Patent Term Adjustment is being filed pursuant to 35 U.S.C. § 154(b), 37 C.F.R. §§ 1.702-1.705 and the March 31, 2008 Petition Decision (“the Petition Decision”). This Request for Reconsideration seeks an additional 100 days of patent term adjustment in addition to the 534 days provided in the Issue Notification mailed on May 14, 2008. The fee set forth in 37 C.F.R. § 1.18(e) has previously been paid and, pursuant to the Petition Decision, no further fee is required for this Request for Reconsideration. The statement of facts supporting this Request for Reconsideration of the December 7, 2007 Application for Patent Term Adjustment as required by 37 C.F.R. § 1.705(b)(2) is set forth herein. Also included herewith is a copy of the December 7, 2007 Application for Patent Term Adjustment and the Petition Decision.

It is respectfully requested that the patent term for United States Pat. No. 7,381,729 (“the ‘729 Patent”) be adjusted from 534 days to 634 days as explained herein. If additional fees for this Application for Patent Term Adjustment are required, the USPTO is hereby authorized to charge Deposit Account No. 13-0019.

STATEMENT OF FACTS UNDER 37 C.F.R. § 1.705(b)(2)

Pursuant to 37 C.F.R. § 1.705(b)(2) Applicants respectfully submit the following Statement of Facts in support of their Request for Reconsideration of the December 7, 2007 Application for Patent Term Adjustment. Applicants hereby request that an additional 100 days of patent term adjustment be granted in addition to the 534 days of patent term adjustment previously granted in the Issue Notification. The requested 100 additional days are the number of days between April 22, 2007 (the day after three years from the application's filing date) and July 30, 2007 (the filing of an RCE). The Applicants are entitled to this additional patent term adjustment pursuant to 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b)(1).

As stated in the Petition Decision, the fee required by 37 C.F.R. § 1.705(b)(1) has been previously paid and no further fee payment pursuant to 37 C.F.R. § 1.18(e) is required.

Pursuant to 37 C.F.R. § 1.705(b)(2), Applicants respectfully submit that the correct patent term adjustment should be 634 days and not the 534 days set forth in the Issue Notification. The bases for this Adjustment are as follows: 477 days pursuant to § 1.702(a)(1), an additional 57 days pursuant to § 1.702(a)(4) and an additional 100 days pursuant to § 1.703(b)(1).

With respect to the 477-day adjustment period, § 1.702(a)(1) states that at least one of either a notification under 35 U.S.C. § 132 or a Notice of Allowance will be mailed within 14 months after filing of the application. The current application was filed on April 21, 2004; therefore, either a notification under 35 U.S.C. § 132 or a Notice of Allowance had to have been mailed by June 21, 2005. The first notification under 35 U.S.C. § 132 (the first Office Action) was mailed on October 11, 2006. Thus, pursuant to § 1.703(a)(1), the Applicants are entitled to a patent term adjustment of a period equal to the number of days between June 22, 2005 (the day after 14 months from the filing of the application) and October 11, 2006. This period of time is equal to 477 days and was correctly calculated by the USPTO in the Notice of Allowance.

With respect to the 57-day adjustment period, § 1.702(a)(4) states that a patent will issue within four months of the issue fee being paid. The issue fee for the '729 Patent was paid on December 7, 2007; therefore, the '729 Patent had to have granted by April 7, 2008. Thus, pursuant to § 1.702(a)(4), the Applicants are entitled to a patent term adjustment of a period equal to the number of days between April 8, 2008 (the day after four months from the payment of the issue fee) and June 3, 2008 (the date the '729 Patent granted). This period of time is equal to 57 days and was correctly calculated by the USPTO.

However, Applicants are entitled to an additional 100 days of patent term adjustment pursuant to § 1.703(b)(1). Section 1.702(b) states that the term of a patent shall be adjusted if its issuance was delayed due to the failure of the USPTO to issue the patent within three years after filing of the application. However, under § 1.703(b)(1) the amount of patent term adjustment based upon the USPTO's failure to issue a patent within three years excludes the amount of time between the filing of an RCE and the issue date of the patent. Thus, Applicants are entitled to an additional patent term adjustment under §§ 1.702(b) and 1.703(b)(1) equal to the number of days between (i) the day after three years from the filing of the application; and (ii) the filing of the RCE. The present application was filed on April 21, 2004; therefore, the day after three years from the filing date is April 22, 2007. Additionally, an RCE was filed in the present application on July 30, 2007. Thus, pursuant to § 1.703(b)(1), Applicants are entitled to a patent term adjustment of a period equal to the number of days between April 22, 2007 and July 30, 2007. This period of time is equal to 100 days. This additional patent term adjustment of 100 days was not included in the 534 days of patent term adjustment stated in the Issue Notification. Applicants respectfully request that the '729 Patent be awarded an additional 100 days of patent term adjustment pursuant to §§ 1.702(b) and 1.703(b)(1) in addition to the 534 days of patent term adjustment granted in the Issue Notification under § 1.702(a)(1) and (a)(4). Thus, pursuant to § 1.703(f), the present application is entitled to a total of 634 days of patent term adjustment.

A summary of the relevant dates is as follows:

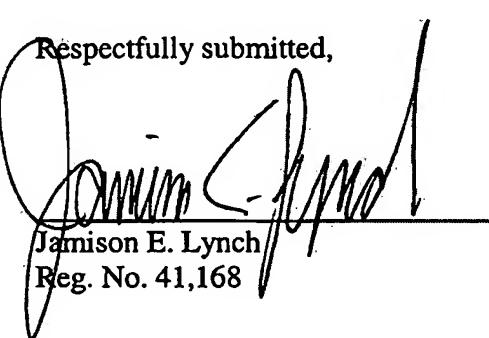
Application filing Date:	April 21, 2004
Application filing Date + 14 months:	June 21, 2005
Date of first Office Action:	October 11, 2006
Filing Date + 3 years:	April 21, 2007
RCE filing date:	July 30, 2007
Issue Fee Payment	December 7, 2007
Issue Fee Payment + 4 months	April 7, 2008
'729 Patent Issue Date:	June 3, 2008

Adjustment Period	Number of Days	37 CFR
June 22, 2005 to October 11, 2006	477	§§ 1.702(a)(1) and 1.703(a)(1)
April 8, 2008 to June 3, 2008	57	§§ 1.702(a)(4) and 1.703(a)(6)
April 22, 2007 to July 30, 2007	100	§§ 1.702(b) and 1.703(b)(1)
TOTAL		634 days

Pursuant to § 1.705(b)(2)(iii), Applicants submit that the '729 Patent is not subject to a terminal disclaimer.

Pursuant to § 1.705(b)(2)(iv)(B), Applicants submit that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the '729 Patent as set forth in § 1.704.

Applicants submit that in view of the foregoing, the present application is entitled to an additional 100 days of patent term adjustment in addition to the 534 days to which the Office has already determined the '729 Patent is entitled. If, in the opinion of the Office, a telephone conference would help expedite the present Application for Patent Term Adjustment, the Office is invited to call the undersigned attorney.

Respectfully submitted,
By: 
Jamison E. Lynch
Reg. No. 41,168

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Dated: June 25, 2008



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MAR 31 2008

OFFICE OF PETITIONS

In re Application of :
Pahl et al. :
Application No. 10/828,650 : ON APPLICATION FOR
Filed: April 21, 2004 : PATENT TERM ADJUSTMENT
Attorney Docket No. 04266864 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT filed December 7, 2007. Applicants request that an additional 100 days of patent term adjustment be granted in addition to the 477 days provided in the Notice of Allowance mailed on September 10, 2007.

The instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date. A decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Patentees are given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the

request. Patentees may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicants are correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on July 30, 2007.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance)

will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT

This Application for Patent Term Adjustment is being filed pursuant to 35 U.S.C. § 154(b) and 37 C.F.R. §§ 1.702-1.705 and requests that an additional 100 days of patent term adjustment be granted in addition to the 477 days provided in the Notice of Allowance mailed on September 10, 2007. Enclosed herewith is the fee (\$200.00) set forth in 37 C.F.R. § 1.18(e) and the statement of facts supporting this Application for Patent Term Adjustment as required by 37 C.F.R. § 1.705(b)(2).

Applicants respectfully request that the patent term for the patent to be granted on allowed application 11/828,650 be adjusted from 477 days to 577 days as explained herein. If additional fees for this Application for Patent Term Adjustment are required, the USPTO is hereby authorized to charge Deposit Account No. 13-0019. To the extent that there has been any over-payment of fees associated with this Application for Patent Term Adjustment, the USPTO is hereby authorized to refund any such over-payment to Deposit Account No. 13-0019.

STATEMENT OF FACTS UNDER 37 C.F.R. § 1.705(b)(2)

Pursuant to 37 C.F.R. § 1.705(b)(2) Applicants respectfully submit the following Statement of Facts in support of their Application for Patent Term Adjustment. Applicants hereby request that an additional 100 days of patent term adjustment be granted in addition to the 477 days of patent term adjustment previously granted in the Notice of Allowance mailed on September 10, 2007. The requested 100 additional days are the number of days between April 22, 2007 (the day after three years from the application's filing date) and July 30, 2007 (the filing of an RCE). The Applicants are entitled to this additional patent term adjustment pursuant under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b)(1).

As required by 37 C.F.R. § 1.705(b)(1), the fee in an amount of \$200.00 as set forth in § 1.18(e) has been paid herewith.

Pursuant to 37 C.F.R. § 1.705(b)(2), Applicants respectfully submit that the correct patent term adjustment should be 577 days and not 477 days as set forth in the Notice of Allowance. The bases for this Adjustment are as follows: 477 days pursuant to § 1.702(a)(1) and an additional 100 days pursuant to § 1.703(b)(1).

With respect to the 477-day adjustment period, § 1.702(a)(1) states that at least one of either a notification under 35 U.S.C. § 132 or a Notice of Allowance will be mailed within 14 months after filing of the application. The current application was filed on April 21, 2004; therefore, either a notification under 35 U.S.C. § 132 or a Notice of Allowance had to have been mailed by June 21, 2005. The first notification under 35 U.S.C. § 132 (the first Office Action) was mailed on October 11, 2006. Thus, pursuant to § 1.703(a)(1), the Applicants are entitled to a patent term adjustment of a period equal to the number of days between June 22, 2005 (the day after 14 months from the filing of the application) and October 11, 2006. This period of time is equal to 477 days (see the attached determination of the number of days) and was correctly calculated by the USPTO in the Notice of Allowance.

However, Applicants are entitled to an additional 100 days of patent term adjustment pursuant to § 1.703(b)(1). Section 1.702(b) states that the term of a patent shall be adjusted if its issuance was delayed due to the failure of the USPTO to issue the patent within three years after filing of the application. However, under § 1.703(b)(1) the amount of patent term adjustment based upon the USPTO's failure to issue a patent within three years excludes the amount of time between the filing of an RCE and the issue date of the patent. Since the period between the filing

of an RCE and the issue date is excluded under § 1.703(b)(1), the amount of adjustment pursuant to § 1.702(b) can be determined independent of the issue date for the present application as an RCE was filed on July 30, 2007. Thus, Applicants are entitled an additional patent term adjustment under §§ 1.702(b) and 1.703(b)(1) equal to the number of days between (i) the day after three years from the filing of the application; and (ii) the filing of the RCE. The present application was filed on April 21, 2004; therefore, the day after three years from the filing date is April 22, 2007. Additionally, an RCE was filed in the present application on July 30, 2007. Thus, pursuant to § 1.703(b)(1), Applicants are entitled to a patent term adjustment of a period equal to the number of days between April 22, 2007 and July 30, 2007. This period of time is equal to 100 days (see the attached determination of the number of days). This additional patent term adjustment of 100 days was not included in the 477 days of patent term adjustment stated in the Notice of Allowance. Applicants respectfully request that the patent granted on the present application be granted the additional 100 days of patent term adjustment pursuant to §§ 1.702(b) and 1.703(b)(1) in addition to the 477 days of patent term adjustment granted in the Notice of Allowance under § 1.702(a)(1). Thus, pursuant to § 1.703(f), the present application is entitled to a total of 577 days of patent term adjustment.

A summary of the relevant dates is as follows:

Application filing Date:	April 21, 2004
Application filing Date + 14 months:	June 21, 2005
Date of first Office Action:	October 11, 2006
Filing Date + 3 years:	April 21, 2007
RCE filing date:	July 30, 2007
Patent Issue Date:	TBD

Adjustment Period	Number of Days	§§ Cited
June 22, 2005 to October 11, 2006	477	§§ 1.702(a)(1) and 1.703(a)(1)
April 22, 2007 to July 30, 2007	100	§§ 1.702(b) and 1.703(b)(1)

TOTAL 577 days

Pursuant to § 1.705(b)(2)(iii), Applicants submit that the present application is not subject to a terminal disclaimer.

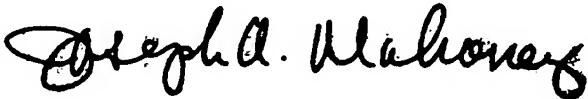
Pursuant to § 1.705(b)(2)(iv)(B), Applicants submit that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the present application as set forth in § 1.704.

In the event that the Office views this Application for Patent Term Adjustment under § 1.705(b) as a premature request for patent term adjustment under § 1.705(d), Applicant hereby reserves the right to resubmit the foregoing arguments after grant of the patent and any other arguments in support of a patent term adjustment. Additionally, Applicants do not waive any other bases for patent term adjustment to which they may be entitled under § 1.705(d).

Applicants submit that in view of the foregoing, the present application is entitled to an additional 100 days of patent term adjustment beyond the 477 days to which the Office has already determined the present application is entitled. If, in the opinion of the Office, a telephone conference would help expedite the present Application for Patent Term Adjustment, the Office is invited to call the undersigned attorney.

Respectfully submitted,

By:


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Dated: December 7, 2007

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To and including: **Wednesday, October 11, 2006**

It is **477** days from the start date to the end date, end date included

Or 1 year, 3 months, 20 days including the end date

Alternative time units

477 days can be converted to one of these units:

- 41,212,800 seconds
- 686,880 minutes
- 11,448 hours
- 68 weeks (rounded down)

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Duration calculation results

From and including: **Sunday, April 22, 2007**

To and including: **Monday, July 30, 2007**

It is **100** days from the start date to the end date, end date included

Or 3 months, 9 days including the end date

Alternative time units

100 days can be converted to one of these units:

- 8,640,000 seconds
- 144,000 minutes
- 2400 hours
- 14 weeks (rounded down)

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